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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,596	07/27/2001	Mark A. Adams	16356.634 (DC-02914)	8710
27683 7590 05/03/2007 HAYNES AND BOONE, LLP 901 MAIN STREET, SUITE 3100 DALLAS, TX 75202			EXAMINER REILLY, SEAN M	
			ART UNIT 2153	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

09/916,596

Applicant(s)

ADAMS ET AL.

Examiner

Sean Reilly

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

This Office action is in response to Applicant's amendment and request for reconsideration filed on February 13, 2007. Claims 1-30 are presented for further examination. All independent claims have been amended.

#### ***Response to Arguments***

1. In response to Applicant's request for reconsideration filed on August 21, 2006, the following factual arguments are noted:
  - a. Guheen and O'Connor failed to disclose providing customers customized data about specific offerings and entitlements available to the customer as recited in the newly added claim limitations.
  - b. There is no motivation in the references for the combination of Guheen and O'Connor.

In considering (a), Examiner respectfully disagrees with Applicant's arguments.

Guheen clearly disclosed providing customers customized data about specific offerings and entitlements available to the customer. For instance Guheen disclose providing customers web-based services for each solution purchased and associated with the particular login profile and customer. Such services include providing downloads of software fixes/updates, future purchasing plans, and reduced price offerings (see inter alia Col 234, line 43 – Col 235, line 31 and Col 239, lines 60 – Col 240, line 16). Examiner maintains that at the very least any one of

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Guheen's above listed services may be equated to Applicant's claimed customized data about specific offerings and entitlements available to the customer.

In considering (b), Examiner respectfully disagrees with Applicant's arguments.

Applicant asserts that there is no motivation in the references for the combination of Guheen and O'Connor. Examiner respectfully disagrees. Foremost, Examiner notes that O'Connor is solely utilized to teach that it was widely known in the art at the time of Applicant's invention to identify customized production solutions by an identifier. Guheen provides a system for selling product solutions. Each solution typically includes multiple computer systems and software packages. Although Guheen does not explicitly disclose associating each solution with an identifier, at the very least Guheen provides some method of associating purchased solutions (and their associated subcomponents) with customer profiles in order to provide customized support for the custom solution sold to each customer (see inter alia Col 239, lines 60-64).

Furthermore, as maintained in the previous office actions and this office action, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Guheen's system to identify customized production solutions by an identifier, as disclosed by O'Connor, so that the particular components of each product solution sold may be effectively identified and associated with that product solution (O'Connor Col 3, lines 11-34). Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In*

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*re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In the instant case and clearly evident in the above obviousness rationale, the motivation for the combination of Guheen and O'Connor comes directly from within the O'Connor reference and is not based on hindsight. Thus, contrary to any of Applicant's assertions, Examiner maintains that the combination of Guheen and O'Connor is proper.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**2. Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guheen et al. (U.S. Patent Number 6,957,186; hereinafter Guheen) and O'Connor et al. (U.S. Patent Number 5,745,568; hereinafter O'Connor).**

3. With regard to claims 1, 8, 9, 10, 15-18, 23, 29, and 30, Guheen disclosed a solutions-based computer system manufacturing process comprising:

- a. responsive to a customer order or plan, assembling distinct computer and storage system components for creation of a given solution-based product as a function of the customer order or plan (e.g. a customer orders an e-commerce solution including the necessary hardware and software components, see inter alia Col 14, lines 62-67, Col 177, lines 1-66, Col 187, lines 1-44, and Col 189, lines 12-64);

- b. providing an entry form for entering solution objects and service tags of components to identify a respective solutions-based system (solution purchase and registration of each component Col 239, lines 61-66) and providing custom-support services as a function of the identified solutions-based system, the web services including dynamically generated web pages defining types of services (e.g. providing the customer web-based support for the solution purchased and associated with that particular login profile and customer; such support including a technical support library and downloads of software fixes/updates among others, see inter alia Col 234, line 43 – Col 235, line 31 and Col 239, lines 60 – Col 240, line 16).
- c. the identified solutions-based system being linked to a configuration of systems and software provided to be updated to reflect a customer's changing installed solution (e.g. Asset management for the life of a sold product solution including both hardware, software, and the relationships between each, see inter alia Col 146, lines 17-26, Col 147, lines 12-20, Col 150, lines 36-42), whereby a customer may possess multiple installed solutions (e.g. user's or organization may purchase multiple solutions, Col 177, lines 43-44) for providing users of the identifier customized data based on a particular customer solution and about specific offerings and entitlements available to the customer (e.g. providing the customer web-based services for the solution purchased and associated with that particular login profile and customer; such services including a technical support library, downloads of software fixes/updates, future purchasing plans, and reduced price offerings, see inter alia Col 234, line 43 – Col 235, line 31 and Col 239, lines 60 – Col 240, line 16).

Guheen disclosed the invention substantially as claimed however, Guheen failed to specifically recite that the solution-based product is assigned a solution type and unique identifier. Nonetheless, Guheen's system at the very least provides some method of associating purchased solutions (and their associated subcomponents) with customer profiles in order to provide customized support for the custom solution sold to each customer (see inter alia Col 239, lines 60-64). Furthermore, it was widely known in the art at the time of Applicant's invention to identify solutions sold to customers by a solution type and unique identifier, as evidenced by at least O'Connor. In analogous system, O'Connor disclosed that customized solutions are assigned a solution type (model) and unique identifier (serial number) during the manufacturing process in order to properly identify the components of that particular product solution (O'Connor Col 3, lines 11-34). Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Guheen's system to identify customized production solutions by an assigned solution type (model) and unique identifier (serial number), as disclosed by O'Connor, so that the particular components of each product solution sold may be effectively identified and associated with that product solution (O'Connor Col 3, lines 11-34).

4. With regard to claims 2 and 26, Guheen disclosed the solution-based product includes solution-based storage products (e.g. Business2 Directory server, Col 20, lines 40-45).
5. With regard to claims 3, 4, and 25, Guheen disclosed the solutions-based system includes at least an e-commerce configuration product ("electronic commerce" Col 19, lines 16-19).
6. With regard to claims 5, 11, and 13, Guheen disclosed the solution-based products includes at least one of component forming an integral part of a larger solution with complex

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interdependencies (e.g. the various components of the Business2 product that work together to facilitate e-commerce transactions, see inter alia Columns 19 and 20).

7. With regard to claims 6 and 27, Guheen disclosed associating service tags (any component identifier) of the components of a respective solution (i.e. solution registration of each component Col 239, lines 61-66) and in the combined Guheen and O'Connor system that solution is associated with a solution identifier (serial number, O'Connor Col 3, lines 11-34).

8. With regard to claims 7 and 28, Guheen and O'Connor failed to disclose storing the associated service tags in a table and indexing the table according to the solution identifier.

Nonetheless Examiner takes Official Notice that it was widely known in the art at the time of Applicant's invention to utilize a table for indexing components of a larger entity for the efficient storage and retrieval of the data. Thus, it would have been obvious to one ordinary skill in the art the time of the invention to store the associated service tags in a table and index the table according to the solution identifier, in order to provide for the efficient retrieval of the product solution and the components that comprise that product solution. The retrieval is more efficient since the format of the data is well structured and therefore readily accessible.

9. With regard to claim 12, Guheen disclosed providing an entry form for entering at least one of solution objects and service tags of additional components of a respective solutions-based system post issuance of the PowerTag identifier and responsive to a completion of the entering of the at least one of solution objects and service tags of the additional components, updating associated of the solution objects and service tags of the additional components with the PowerTag identifier, wherein the updated PowerTag identifier associations facilitate obtaining of



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custom service for additional components as a function of the PowerTag identifier (i.e. registration of the components the customer currently possesses; Col 239, lines 60-66).

10. With regard to claim 14, Guheen disclosed the claimed hardware and support features (see for example the hardware components of Business1 and Business2 product solutions Columns 15-22 and the necessary software updates required for each Col 235, lines 6-18; also see the levels of support provided and consulting services provided Col 239, line 60 – Col 240, line 18).

11. With regard to claim 19, Guheen disclosed web pages are a function of the type of support service being requested including at least one on-line support (see inter alia Col 234, line 43 – Col 235, line 31 and Col 239, lines 60 – Col 240, line 16).

12. With regard to claims 20-21, Guheen failed to specifically recite providing updates that include updates to a cluster configuration or the firmware of particular components. Nonetheless Guheen disclosed providing updates to all components of the solution sold (see inter alia, Col 235, lines 6-31). Furthermore Examiner takes Official Notice that clusters were widely utilized in computer solutions sold at the time of Applicant's invention. Examiner also takes Official Notice that hardware devices typically utilized firmware in order to boot and operate properly at the time of Applicant's invention. Thus, the solutions sold by Guheen would necessarily include both cluster configurations and/or hardware devices with firmware. Accordingly, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to provide updates to both cluster configurations and the firmware of various hardware devices when they are present in the solutions sold by Guheen since Guheen disclosed providing updates for the solution sold and the respective components within the that particular solution.

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13. With regard to claim 22, Guheen disclosed determining a scope of work and any products required for use in an upgrading of the solutions-based product as a function of the identifier (Col 239, lines 39-48).

*Conclusion*

14. The prior art made of record, in PTO-892 form, and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean Reilly whose telephone number is 571-272-4228. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

April 17, 2007

  
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